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PATENT APPLICATION

ATTORNEY DOCKET NO. 10006799-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Borg, et al.

Confirmation No.: 6674

Application No.: 09820457

Examiner: Nguyen, Tan D.

Filing Date: March 28, 2001

Group Art Unit: 3629

Title: Systems and Methods for Utilizing Printing Device Data in a Customer Service Center

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on March 7, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1580☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Respectfully submitted,

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MAY 05 2006

PATENT APPLICATION
Docket No. 10006799-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
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	BORG, et al.)
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Serial No.:	09/820,457) Appeal
No.)
)
Confirmation No.	6674)
)
Filed:	March 28, 2001)
)
For:	Systems and Methods for Utilizing Printing)
	Device Data in a Customer Service Center)
)
Examiner:	Nguyen, Tan D.)

The Honorable Commissioner of Patents
Mail Stop Appeal Brief - Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

BRIEF OF APPELLANT

The Appellant has filed a timely Notice of Appeal from the action of the Examiner in finally rejecting all of the claims that were considered in this application. This Brief is being filed under the provisions of 37 C.F.R. § 1.192. The Filing Fee, as set forth in 37 C.F.R. § 1.17(c), is submitted herewith. Further to a Final Office action dated January 12, 2006 and a Notice of Appeal filed on March 7, 2006, the following is applicants' brief on appeal.

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REAL PARTY IN INTEREST

The real party of interest is Hewlett-Packard Company. The assignee is Hewlett-Packard Development Company, LP, a Texas limited partnership and a wholly owned affiliate of Hewlett-Packard Company.

RELATED APPEALS AND INTERFERENCES

None.

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STATUS OF CLAIMS

Allowed Claims: No claims have been allowed.

Cancelled Claims: Claims 20-25 were previously cancelled.

Pending Claims: Claims 1-19 are pending in the application and stand finally rejected by the Examiner.

Appealed Claims: All of the pending claims are subject to this appeal.

STATUS OF AMENDMENTS

A Final Office Action was issued on January 13, 2006 finally rejecting pending claims 1-19 under 35 USC § 103. Claims 1-19 are unamended original claims.

Appellant filed a Notice of Appeal on March 7, 2006 in response the Final Office Action.

SUMMARY OF INVENTION

Beginning at page 7 of the subject Application, methods, systems and devices for utilizing printing device data in a customer service center are described. For example, a printer employing a toner cartridge (or other replaceable component) is described wherein a memory tag is affixed to the toner cartridge or integrated into the toner cartridge. As the printer operates, information related to the printer and its usage is stored in the memory tag. This information may include printer identifying information, such as a model number of the printer, a serial number of the printer, etc. This information also includes printer usage data that includes, but is not limited to, total number of pages printed by the printer, number of pages printed from the toner cartridge, average amount of coverage on a page printed by the printer, percentage of print job that only use black ink, etc. When the toner cartridge runs out of toner, the customer returns the depleted toner cartridge to the manufacturer for recycling at step. The recycling center receives the toner cartridge and retrieves the data from the memory tag of the toner cartridge and stores the data in the customer database. The databasc may be accessed by a customer service representative to assists customer.

Following is a brief summary of independent claims 1, 10 and 16 with exemplary references to the disclosure inserted for convenience. References should not be understood as limiting any feature to the recited portions of the disclosure.

Claim 1 recites a method, comprising: retrieving printing device data (FIG.4, block 408; p. 14 l. 7 – p. 15 l. 10) from component memory (108) of a replaceable component (100) from a printing device (206-214) used by a customer (202); storing the printing device data in a customer database (FIG.2 , database 224; FIG.3 database 300); associating the printing device data with the customer (FIG. 3, customer field 308; p. 11, l. 17- p.12 l. 2); and accessing the printing device data in the customer database to assist the customer with solving problems related to the printing device . (FIG. 5, step 504; p. 16 ll., 12-20).

Claim 10 recites a system, comprising: a recycling center (218) to receive a used printing device replaceable component (100) from a printing device (206-214) of a customer, the printing device replaceable component including component memory (108)integrated therewith; a customer database (FIG.2 , database 224; FIG.3 database 300) that stores customer information for multiple customers, including printing devices and printing device replaceable components used by the customers (202); a data transfer center (219) wherein printing device data is retrieved from the component memory and stored in the customer database; and a customer service center (220) configured to receive calls from the customer and provide operator access to the customer database so that the operator can view the printing device data. (FIG. 2; p. 8, l. 14 – p. 11, l. 7).

Claim 16 recites a method for assisting customers having problems with printing devices that use replaceable components (100) with integrated component memory (108), the method comprising: compiling data (FIG.4, block 408; p. 14 l., 7 – p. 15 l., 10) retrieved from the component memory of a plurality of replaceable components into a customer database (FIG.2 , database 224; FIG.3 database 300); accessing the customer database to view compiled data that is related to a specific customer or to a printing device that is used by a specific customer to resolve a problem the customer is having with the printing device (FIG. 5, step 504; p. 16 ll., 12-20).

GROUND OF REJECTION

1. Whether Claims 1-19 are unpatentable under 35 U.S.C. § 103 as being unpatentable over U.S. Published Patent Application No. 2002/0075145 to Hardman et al. (hereinafter "Hardman") in view of U.S. Patent No. 6,386,772 to Klinefelter et al. (hereinafter "Klinefelter").

ARGUMENT

FIRST GROUND OF REJECTION: Claims 1-19 are patentable under 35 U.S.C. §103 over Hardman in view of Klinefelter.

1. The §103 rejection of claims 1-19 is not proper because Hardman is nonanalogous art in relation to the instant Application.

First, it is respectfully submitted that Hardman is nonanalogous art in relation to the recited features of Claims 1-19. As the Examiner is well aware, “[i]n order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). *See MPEP 2141.01.*

The Applicant respectfully asserts that Hardman is nonanalogous art and may not be relied upon in the rejection of the above referenced claims. Hardman is drawn exclusively towards a tire monitoring system. For example, Hardman recites that the “present invention relates in general to tire parameter monitoring systems and in particular to an electronic tire management system including tire tags,” *See Hardman*, Page 1, Paragraph [002]. Hardman therefore limits its own scope to tire monitoring. Hardman repeatedly refers to “tire tags”, “tire data”, and defines the system as “Electronic Tire tag Management System (ETMS)” and does not disclose any other

contemplated use. *See Hardman*. Hardman merely describes a system for retrieving tire parameter data from tires. Hardman is not drawn to and does not suggest any application outside of monitoring tires.

MPEP § 2141.01(a) titled "Analogous and Nonanalogous Art" contains the following discussion of *Oetiker* which is instructive on this point:

See, for example, *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) . . . Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. **The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.** (emphasis added). *MPEP § 2141.01(a)*

Thus, in *Oetiker* it was held that a reference was not reasonably pertinent to the particular problem of the invention where a person of ordinary skill, seeking to solve the problem at hand (hose clamps), would not reasonably be expected or motivated to look to the subject matter of the reference (garment clamps). While the Office reasoned that "all hooking problems are analogous", this broad grouping of the invention and reference as generally addressing hooking problems did not resolve the fact that one of ordinary skill looking to solve the particular problem would not

reasonably turn to a reference dealing with entirely different subject matter.

The present case parallels the situation in *Oetiker*. Just as in *Oetiker*, the Examiner attempts to broadly group the invention and reference, reasoning that “both applications deal with electronic data collection, monitor, and problem identification (diagnostics) of a device”. *Office Action dated 1/13/2006*, p.2. However, just as this type of reasoning was insufficient in *Oetiker* to cause the reference dealing with garment hooks to be analogous art in reference to hose clamps, so too it is insufficient here to permit the use of the Hardman tire monitoring disclosure against the instant application dealing with printer device data.

Rather, it must be shown that artisan in the Applicant’s field of endeavor seeking to manage data collected from a printing device would “reasonably be expected or motivated to look” to the tire monitoring system of Hardman. However, it does not logically follow that an artisan attempting to address printer data management would reasonably turn to a reference dealing exclusively with tires, even though both may deal with electronic data collection. More likely, even if the artisan working on a printing problem was aware of such a tire monitoring reference, the tire monitoring reference would be cast aside as irrelevant to printing problem being addressed.

The broad grouping under “electronic data collection” is simply too attenuated to support the use of the Hardman reference against the instant Application. The

instant Application relates generally to managing data collected from printing devices and more particularly to retrieving data from printing device components that have memory and utilizing the printing device data to provide improved customer service. Nowhere in Hardman is there disclosure, teaching or suggestion of printing devices, printers, printer data, or the like. Hardman does not describe any other use besides tire monitoring. Tires and printers are significantly different fields which the ordinary artisan would not logically link. Therefore, an artisan in the Applicant's field of endeavor seeking to manage data collected from printing device simply would not look to a tire monitoring system as described in Hardman. Accordingly, Hardman is non-analogous prior art. For at least this reason, the applicant respectfully requests that the §103 rejections of claims 1-19 be overturned.

2. The §103 rejection of claims 1-19 in not proper because Hardman and Klinefelter, alone or in combination, fail to teach or suggest all the recited features of claim 1-19.

In addition to reliance on nonanalogous art, it is respectfully submitted that the combination of references suggested by the Office herein rejecting the above referenced claims is defective. When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references

must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986)*. The features of Claims 1-19 are not disclosed, taught or suggested by the cited art, alone or in combination. For the sake of brevity arguments will be made with respect to Claim 1 followed by a discussion in subsequent points of other claims referencing this argument.

Claim 1 recites a method that includes “retrieving printing device data from component memory of a replaceable component from a printing device used by a customer; storing the printing device data in a customer database”. As previously described, Hardman does not teach or suggest “printing device data”, “component memory” integrated with a “replaceable printer component”, or “printing device data is retrieved from the component memory and stored in the customer database” as recited in Claim 1.

The Examiner asserts that “[a]s for the limitation of ‘printing device’ data, this is non-functional language and carry no-patentable weight since it’s merely non-functional data on a storage device”. *Office Action dated 1/13/2006*, p. 4-5. This is not the case, Claim 1 recites “retrieving printing device data from component memory of a replaceable component from a printing device used by a customer” which

positively recites a device involved in the performance of the “retrieving”. Therefore, this is functional language and the Examiner is not free to ignore this feature of the recited claim.

Regardless, the Examiner then asserts Klinefelter to correct the defects of Hardman, and more particularly the absence in Hardman of any mention whatsoever of a device other than a tire. Namely, the Examiner asserts that Klinefelter “teaches the retrieving of data from component memory (tag/memory tag) of a replaceable component (toner/ink cartridge) from a device (i.e. printing device) used by a customer {see Figs. 9, 7 or col. 5, line 5 to col. 6, line 61, col. 1, lines 5-18}”. *Office Action dated 1/13/2006*, p. 6. The Applicant respectfully disagrees.

Klinefelter describes communication of information within an electronic printer. For example, a make and supplier of a ribbon may be included such that operation of a print head may be optimized by communicating this information from the ribbon to the electronic printer. *Klinefelter*, col. 5, Lines 60-67. Thus, the information communicated within Klinefelter serves the sole purpose of informing the printer of materials being used and does not teach or suggest the recited method. Klinefelter does not teach or suggest any other use of the data. Accordingly, Claim 1 is allowable for this reason and it is respectfully requested that the §103 rejection be overturned. The argument made here with respect to claim 1 is applicable to claims 2-19 as referenced in the respective discussion of those claims below.

3. The §103 rejection of claims 1-19 is not proper because the proposed combination of Hardman and Klinefelter is based upon impermissible hindsight reconstruction.

Additionally, the Applicant respectfully submits that the Examiner has engaged in impermissible hindsight reconstruction. The Applicant respectfully submits that the Examiner has not provided the required teaching or suggestion from the prior art to make the claimed combination, and rather has engaged in impermissible hindsight reconstruction. Again, for the sake of brevity this argument will be made with respect to claim 1 followed by a discussion in subsequent points of other claims referencing these arguments.

As previously described, Hardman is drawn exclusively towards a tire monitoring system. Hardman recites that the “present invention relates in general to tire parameter monitoring systems and in particular to an electronic tire management system including tire tags,” *Hardman*, p. 1, paragraph [002]. Hardman therefore limits its own scope to tire monitoring. Hardman repeatedly refers to “tire tags”, “tire data”, and defines the system as “Electronic Tire tag Management System (ETMS)” and does not disclose any other contemplated use. *See Hardman*. However, each of the recited features of claim 1, e.g., the “retrieving”, the “storing”, the “associating” and the “accessing”, involve printing device data.

Klinefelter describes communication of data within a printer and does not

describe any other contemplated use other than use within the printer itself to perform printing functions, such as to control a print head. Therefore, a skilled artisan, when viewing both references, would not be motivated to make the proposed combination absent the present disclosure.

The Examiner asserts in the Office Action that "Clearly, the mere applying the same essential retrieving, storing, associating and accessing the data steps from a memory tag of a replaceable component to/of any other device would have been obvious to a skilled artisan since the type or different function of the device is not critical and any device can be used". *Office Action dated 1/13/2006, 2005, p. 7.*

The Applicant strongly disagrees. Claim 1, as originally filed, particularly recites printer data and therefore is drawn with particularity to printer data. Hardman, however, merely recites tire tag data and does not describe any use whatsoever outside of tires. Therefore, Hardman itself supports the Applicant's contention that the present claim is nonobvious, since the lack of support within Hardman for any other contemplated use whatsoever, much less printer use, shows the narrow scope of the problem being addressed by Hardman. The Examiner is now not free, with the benefit of hindsight reconstruction afforded by the present Application, to then expand the scope of Hardman beyond its expressed teachings. The Office has not provided the required teaching or suggestion from the prior art to make the claimed combination, and rather has engaged in impermissible hindsight reconstruction.

In addition, the examiner states that:

To an Engineer, the application of the same electronic data collection, monitor and problem identification (diagnostics) of a device using RFID tag system to any devices of different functions, for printing, copying, moving, heating, calculating, etc. are within the skill of the artisan. In fact, the functions of the device are non-essential and within the skill of the artisan to make minor adjustments to the specific device to carry out the main goal of electronic data collection, monitor, and problem identification (diagnostics) of a device using RFID tag. *Office Action dated 1/13/2006, p. 3.*

It appears from these excerpts that the examiner has based the obviousness determination on the fact that the proposed modifications are within the skill of the artisan. In response, the Applicant respectfully asserts that Examiner has applied an improper standard. Even assuming for the sake of argument that the prior art references teach all the claimed features, the fact that references may be combined, or that the combination is within the skill of an artisan is insufficient to establish a *prima facie* case of obviousness. MPEP § 2143.0 for instance describes:

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); MPEP § 2143.0.*

The Examiner's conclusion here that the proposed modifications were within the skill of the artisan does not relieve the Examiner of the obligation to provide some

objective reason to combine the teachings of the references.

Further, Applicant respectfully asserts that the examiner's global statement that "In fact, the functions of the device are non-essential and within the skill of the artisan" indicates that recited features of the applicant's claims were improperly neglected. The Applicant's invention in the case of each claim includes everything which is recited in the claim. Contrary to the Examiner's assertion, the recited features further define the claimed invention and are essential. Recited features may not simply be dismissed as non-essential to the claimed invention.

Accordingly, Claim 1 is allowable for these additional reasons and it is respectfully requested that the §103 rejection be overturned. The argument made here with respect to claim 1 is applicable to claims 2-19 and is referenced in the respective discussion of those claims below.

4. **Claims 2-9 are allowable based on their dependency to claim 1 as well as for their own recited features which the proposed combination of Hardman and Klinefelter fails to teach or suggest.**

Claims 2-9 depend directly or indirectly from Claim 1 and are allowable for at least the same reasons as stated with respect to Claim 1 above in points 2 and 3. These claims are also allowable for their own recited features which are not disclosed, taught or suggested by the cited references, alone or in combination

In regards to dependent Claims 2-9, the Applicant strongly disagrees with the

assertion again made by the Examiner that the recited features of Applicant's invention are "non-essential to the claimed invention". *Office Action dated 1/13/2006, p. 8-10*. As noted in the previous discussion, the Applicant's invention in the case of each claim includes everything which is recited in the claim. Contrary to the Examiner's assertion, the recited features further define the claimed invention and are essential. Recited features may not simply be dismissed as non-essential to the claimed invention. Rather, "The prior art reference (or references when combined) must teach or suggest all the claim limitations". See *MPEP 2143*. In addition, the Applicant strongly disagrees with the "fairly taught" standard repeatedly asserted by the Examiner. *Office Action dated 1/13/2006, p. 8-10*. To the extent that "fairly taught" as asserted by the Examiner deviates from the statutory requirements for patentability the standard is erroneous.

Further, the Examiner "ordinarily should reject each claim on all valid grounds available." *M.P.E.P. §707.07(g)* Further, "[w]here a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression." *Id.* The Examiner's action should be complete as to all matters. *37 C.F.R. 1.104 and M.P.E.P. §707.07(a)*. Failure to provide a full development of the reasons removes any opportunity for the Applicant to rebut any reasoning used by the Examiner in making the rejections. As the following discussion illustrates and contrary to the Examiner's contention that

recited features are “non-essential to the claim invention”, each of claims 2-9 recite respective features which further define the subject matter of the invention and which are patentable over Hardman and Klinefelter, alone or in combination.

Claim 2 recites “the printing device data further comprises information that uniquely identifies the printing device”. **Claim 3** recites “the printing device data further comprises information regarding usage of the printing device”. Hardman does not teach or suggest information that uniquely identifies the printing device as recited in Claim 2. Additionally, Hardman does not teach or suggest information regarding usage of the printing device as recited in claim 3. Hardman does not discuss information about the printer or usage. Rather, the portions of Hardman relied upon by the Examiner merely describe the outputting of tire parameter data locally or remotely, tire and tire tag serial numbers, tire tag features, and the editing of vehicle and tire data on a tire tag. *See Hardman Paragraphs [0119], [0145],[0149],[0265] and [0309]*. Hardman is narrowly drawn to tire parameter monitoring. Indeed, Hardman includes a very extensive “Field of the Invention” section that is limited exclusively to tire monitoring. Hardman does not discuss printer device data or printer information at all. Klinefelter does not correct these defects, alone or in combination with Hardman. Since Klinefelter identifies components (e.g., a ribbon) and not a printing device, Klinefelter cannot correct the defects of Hardman. Thus, claims 2 and 3 are allowable as written, and it is respectfully requested that the §103

rejection of these claims be overturned.

Claim 4 recites “wherein the accessing the printing device data in the customer database further comprises accessing previously stored database information related to the customer”. **Claim 5** recites “wherein the previously stored database information is derived from memory of previously returned components”. The Examiner relies upon portions of Hardman that describe only “tire history data” downloaded or transferred from a tire tag. *See Hardman, Paragraphs [0151], [0152], and [0169]*. Hardman fails to disclose “accessing the printing device data in the customer database” or “accessing previously stored database information related to the customer” as recited in claim 4. Additionally, Hardman fails to disclose accessing previously stored database information “from the memory of previously returned components” as recited in claim 5. Further, Hardman fails to teach or suggest “previously returned components” at all. Klinefelter does not correct these defects, alone or in combination with Hardman. Thus, Hardman and Klinefelter fail to teach or suggest all the claim features of claims 4-5. Thus, claims 4-5 are allowable as written, and it is respectfully requested that the §103 rejection of these claims be overturned.

Claim 6 recites “wherein the previously stored database information is derived from information submitted by the customer on a registration card”. Examiner relies upon portions of Hardman that fail to disclose “information submitted upon a

registration card” as recited in Claim 6. See Hardman Paragraph, [0145] and [0152]. Hardman does not mention a registration card, and thus fails to teach or suggest all the claimed features of claim 6. Klinefelter does not correct these defects, alone or in combination with Hardman. Thus, Hardman and Klinefelter fail to teach or suggest all the claim features of claim 6. Claim 6 is allowable as written, and it is respectfully requested that the §103 rejection be overturned.

Claim 7 recites “wherein the printing device is a laser printer and the replaceable component is a toner cartridge”. The Examiner yet again asserts that this feature is non-essential to the claimed invention, which again is improper. Claim 7 is allowable as written, and it is respectfully requested that the §103 rejection be overturned.

Claim 8 recites “further comprising associating rules to be followed when printing device data associated with a customer meets certain criteria”. Examiner relies upon a portion of Hardman which describes calculating Cold Fill Inflation Pressure and comparing to a specified target. See Hardman Paragraph [0224]. Hardman, however, fails to disclose “associating rules to be followed when printing device data associated with a customer meets certain criteria” as recited in Claim 8. Klinefelter does not correct this defect, alone or in combination with Hardman. Thus, Hardman and Klinefelter fail to teach or suggest all the claimed features of Claim 8. Claim 8 is allowable as written, and it is respectfully requested that the §103 rejection

be overturned.

Claim 9 recites a method comprising in part “testing the replaceable component for a defect”, “storing defect information in the customer database”, “associating the defect information to one or more other customers referred to in the customer database that use a similar replaceable component” and “wherein the accessing the printing device data further comprises accessing the defect information in the customer database”. The Examiner relies upon a portion of Hardman which describes using actual tire parameter data from a tire tag to determine which tires “are in need of service, such as being under-inflated” such that they “can be attended to immediately” while “other tires that require no service can then be given no attention other than a routine visual inspection”. *See Hardman Paragraphs [0234]-[0235]*. Hardman describes using tire tag data to determine which tires should be serviced. Hardman does not teach or suggest the above recited features of Claim 9. Hardman fails to teach or suggest “testing for the replaceable component for a defect”, “storing defect information”, “associating defect information to one or more other customers”, or “accessing the defect information” as recited in claim 9. Indeed, Hardman does not describe defect testing or storing/accessing defect information at all. Klinefelter does not correct this defect, alone or in combination with Hardman, and thus these references fail to teach or suggest all the claimed features of Claim 9. Claim 9 is allowable as written, and it is respectfully requested that the §103 rejection be

overturned.

Accordingly, for these and other reasons, the Applicant respectfully requests that the §103 rejection of Claims 2-9 be overturned. The arguments made here with respect to claim 2-9 are applicable to corresponding claims 11-15 and 17-19 and are referenced in the respective discussion of those claims below.

5. **Independent claims 10 and 16 are allowable because the combination of Hardman with Klinefelter does not teach or suggest all the claimed features and the rejections are based upon hindsight knowledge of the Applicant's invention which is impermissible.**

Claim 10 recites a system that includes “printing device replaceable component including component memory integrated therewith”, “a customer database that stores customer information for multiple customers, including printing devices and printing device replaceable components used by the customers” and “printing device data is retrieved from the component memory and stored in the customer database”.

Claim 16 recites a method that includes “printing devices that use replaceable components with integrated component memory” and “compiling data retrieved from the component memory of a plurality of replaceable components into a customer database”. Neither Hardman nor Klinefelter, alone or in combination, disclose, teach or suggest these aspects.

Claims 10 and 16 are allowable over Hardman in view of Klinefelter for

reasons previously recited in points 2 and 3 above with respect to claim 1. As previously described with respect to Claim 1, Hardman does not disclose, teach or suggest a "printing device" or "component memory", features which are also recited in Claims 10 and 16. The combination of Hardman with Klinefelter does not correct the defect in Hardman. Further, for reasons previously recited with respect to Claim 1, the proposed combination of Hardman and Klinefelter depends upon hindsight knowledge of the Applicant's invention which is impermissible. Accordingly, the Applicant respectfully requests that the §103 rejection of Claims 10 and 16 be withdrawn.

6. Claims 11-15 are allowable based on their dependency to claim 10 as well as for their own recited features which the proposed combination of Hardman and Klinefelter fails to teach or suggest.

Claims 11-15 depend directly or indirectly from Claim 10 and are allowable for at least the same reasons as stated with respect to Claim 10 in point 5 above. These claims are also allowable for their own recited features, which are not disclosed, taught or suggest by the submitted references, alone or in combination. The discussion with respect to claims 2-9 in point 4 above is pertinent to claims 11-15 as well. Therefore, the Applicant will not further burden the record by repeating the above remarks. Accordingly, Hardman fails to teach or suggest the recited features of claims 11-15 for the corresponding reasons set forth above with respect to claims 2-9.

Klinefelter fails to correct the defects in Hardman. For at least these reasons, Applicant respectfully requests that the §103 rejection of claims 11-15 be overturned.

7. **Claims 17-19 are allowable based on their dependency to claim 16 as well as for their own recited features which the proposed combination of Hardman and Klinefelter fails to teach or suggest.**

Claims 17-19 depend directly or indirectly from Claim 16 and are allowable for at least the same reasons as stated with respect to Claim 16 in point 5 above. These claims are also allowable for their own recited features, which are not disclosed, taught or suggest by the submitted references, alone or in combination. For example:

Claim 17 recites “storing customer information for a customer in the customer database and associating the customer information with compiled data that is related to a printing device used by the customer”. Hardman and Klinefelter fail to teach or suggest “associating the customer information with compiled data that is related to a printing device used by the customer” as recited in Claim 17. Applicant respectfully requests that the §103 rejection of claim 17 be overturned.

Claim 18 recites “acquiring the customer information for the customer from a registration card used to register the customer as the purchaser of the printing device used by the customer”. Claim 18 is rejected for the same reason as set forth for Claim 6. As with Claim 6 discussed above, Hardman and Klinefelter, alone or in

combination, fail to teach or suggest "a registration card" as recited in claim 18.

Applicant respectfully requests that the §103 rejection of claim 18 be overturned.

Claim 19 recites "associating the customer information with general data related to a printing device or printing device replaceable component used by a customer". As discussed previously, Hardman deals with tires and not printer devices, and Klinefelter is not properly combinable with Hardman. Hardman does not teach or suggest "printing device" or "printing device replaceable component" as recited in claim 19. Applicant respectfully requests that the §103 rejection of claim 19 be overturned.

For at least the above reasons, Applicant respectfully requests that the §103 rejection of claims 17-19 be overturned.

8. Hardman's self-serving boilerplate about the scope of the claims and equivalents thereof doe not form a basis for expanding the scope of Hardman to render Applicant's invention obvious.

The Applicant again strongly disagrees with the Examiner's assertion that Hardman's self-serving boilerplate about the scope of the claims and equivalents thereof renders Applicant's invention obvious. For example, the Examiner in a previous office action asserts the following:

Note on [309] and [313], Hardman et al discloses that any other desired device or parameters can be implemented and that other element, steps, methods and techniques that are insubstantially different from those described herein are also within the scope

of the invention. Thus the scope of the invention should not be limited by the particular embodiments described herein but should be defined by the appended claims and equivalents thereof. Changing to other type of device or component would be considered as selecting other equivalent device and component and would have been obvious, absent evidence of unexpected results. *Office Action dated 6/16/2005, p. 11-12.*

Applicant respectfully disagrees that the scope of the invention in Hardman is expanded by the described boilerplate language. This type of language does not expand the scope of Hardman beyond the described limited scope of tire tags. As previously stated, when applying 35 U.S.C. § 103, "the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination" and "must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention". *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).* Nowhere in the asserted boilerplate is the desirability of the modification suggested without engaging in impermissible hindsight vision afforded by the claims of the subject Application.

Further, [313] states "it will be obvious to those skilled in the art that changes and modifications of the present invention, in its various embodiments, may be made without departing from the spirit and scope of the invention." The spirit and scope of Hardman is clearly limited to tire tags and tire parameter monitoring. This language is clearly limiting and should not serve to broaden the scope of Hardman, and most

certainly cannot be used as a basis for rendering the Applicant's invention obvious.

Accordingly, for the reasons previously described claims 1-19 are patentable under 35 U.S.C. §103 over Hardman in view of Klinefelter, and it is respectfully requested that the Grounds of Rejection be overturned.

CONCLUSION

The Appellant respectfully considers this application to be in condition for allowance and respectfully requests the Board to overturn the final rejection and that the Examiner pass this application to allowance.

Dated this 5 day of May, 2005.

Respectfully submitted,



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CLAIMS APPENDIX

1. (original): A method, comprising:
retrieving printing device data from component memory of a replaceable component from a printing device used by a customer;
storing the printing device data in a customer database;
associating the printing device data with the customer; and
accessing the printing device data in the customer database to assist the customer with solving problems related to the printing device
2. (original): The method as recited in claim 1, wherein the printing device data further comprises information that uniquely identifies the printing device.
3. (original) The method as recited in claim 1, wherein the printing device data further comprises information regarding usage of the printing device.
4. (original): The method as recited in claim 1, wherein the accessing the printing device data in the customer database further comprises accessing previously stored database information related to the customer.

5. (original): The method as recited in claim 4, wherein the previously stored database information is derived from memory of previously returned components.

6. (original): The method as recited in claim 4, wherein the previously stored database information is derived from information submitted by the customer on a registration card.

7. (original): The method as recited in claim 1, wherein the printing device is a laser printer and the replaceable component is a toner cartridge.

8. (original): The method as recited in claim 1, further comprising associating rules to be followed when printing device data associated with a customer meets certain criteria.

9. (original): The method as recited in claim 1, further comprising:
testing the replaceable component for a defect;
if a defect is found, storing defect information in the customer database;
associating the defect information to one or more other customers referred to in
the customer database that use a similar replaceable component; and
wherein the accessing the printing device data further comprises accessing the
defect information in the customer database.

10. (original): A system, comprising:
a recycling center to receive a used printing device replaceable component
from a printing device of a customer, the printing device replaceable component
including component memory integrated therewith;
a customer database that stores customer information for multiple customers,
including printing devices and printing device replaceable components used by the
customers;
a data transfer center wherein printing device data is retrieved from the
component memory and stored in the customer database; and
a customer service center configured to receive calls from the customer and
provide operator access to the customer database so that the operator can view the
printing device data.

11. (original): The system as recited in claim 10, wherein the printing device data further comprises printing device usage information that is stored by the printing device when the printing device is operating with the replaceable component installed.

12. (original): The system as recited in claim 10, wherein the printing device data further comprises information that uniquely identifies the printing device in which the replaceable component was used.

13. (original): The system as recited in claim 10, wherein:
the printing device data further comprises a customer identifier that uniquely identifies the customer utilizing the printing device;

the database further stores the customer identifier and associate the customer identifier with the customer information related to the customer identified by the customer identifier; and

the customer service center is further configured to display the customer information related to customer in response to input of the customer identifier.

14. (original): The system as recited in claim 10, further comprising a quality assurance center where used printing device replaceable components are tested for defects and wherein the customer database further stores data regarding a defect detected in a defective replaceable component for each customer having customer information stored about a replaceable component similar to the defective replaceable component.

15. (original): The system as recited in claim 10, wherein the printing device comprises a laser printer and the replaceable component comprises a toner cartridge.

16. (original): A method for assisting customers having problems with printing devices that use replaceable components with integrated component memory, the method comprising:

compiling data retrieved from the component memory of a plurality of replaceable components into a customer database;

accessing the customer database to view compiled data that is related to a specific customer or to a printing device that is used by a specific customer to resolve a problem the customer is having with the printing device.

17. (original): The method as recited in claim 16, further comprising storing customer information for a customer in the customer database and associating the customer information with compiled data that is related to a printing device used by the customer.

18. (original): The method as recited in claim 17, further comprising acquiring the customer information for the customer from a registration card used to register the customer as the purchaser of the printing device used by the customer.

19. (original): The method as recited in claim 17, further comprising associating the customer information with general data related to a printing device or printing device replaceable component used by a customer.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.